

Image



1614

Response to Requirement of Restriction of December 23, 2003
Attorney Docket No. PC10228B
Ser. No. 09/863,976

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, postage prepaid, addressed to the Commissioner for Patents, Alexandria, VA 22313-1450, on this 23rd day of January, 2004.

By

Martha C. Sibilio

(Signature of person mailing)

Martha C. Sibilio

(Typed or printed name of person)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Farzan Rastinejad, et al. :

APPLICATION NO.: 09/863,976 : Examiner: C. D. Muirhei

FILING DATE: May 23, 2001 : Group Art Unit: 1614

TITLE: METHODS AND COMPOSITIONS FOR :
RESTORING CONFORMATIONAL :
STABILITY OF A PROTEIN OF THE P53 :
FAMILY :

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

The present Reply is in response to the Requirement of Restriction and Election mailed by the Examiner herein on December 23, 2003 requesting an election in response to the Examiner's restriction requirement in the above-captioned case. A shortened statutory period for response to the December 23, 2003 Action is set to expire one month from the mailing date of the Action, i.e., January 23, 2004. Thus, this response is timely submitted.

REMARKS

Claims 26-55 are pending in the present application. In the December 23, 2003 Restriction Requirement the Examiner restricted the claims into two groups, I-II, as follows:

Group I: Claims 26-55, drawn to a method for identifying organic non-peptide compounds useful in the treatment of cancer.

Group II: Claim 56, drawn to a method of evaluating whether an organic compound can promote a wild-type activity in a mutant form of a mammalian protein of the p53 family.

Applicants hereby elect without traverse to prosecute the claims of Group I in this application. Applicants election of Group I subject matter at present, however, does not prejudice applicants' ability to file divisional or continuation applications to unelected subject matter.

Applicants do not believe any additional fees are due in connection with the filing of this response to the April 11, 2003 Restriction Requirement. However, if any fee is due, the Examiner is authorized to charge the fee to applicants' Deposit Account No. 16-1445.

CONCLUSION

Applicants respectfully request prompt consideration of the pending claims and early allowance of the application.

If the Examiner wishes to comment or discuss any aspect of this application or response, applicants' undersigned attorney invites the Examiner to call him at the telephone number provided below.

Respectfully submitted,

Date:

May 8, 2003

E. V. Donahue
E. Victor Donahue
Attorney for Applicants
Reg. No. 35,492

Pfizer Inc
Patent Dept., 5th Floor
150 East 42nd Street
New York, NY 10017
(212) 733-2739

Group I: Claims 26-55, drawn to a method of identifying an organic non-peptide compound, classified in class 436, subclass 91.

Group II: Claim 56, drawn to a method of evaluating whether an organic non-peptide compound can promote activity, classified in class 436, subclass 91.

Applicants wish to respectfully refer the Examiner to the restriction requirement imposed by Examiner Jerome D. Goldberg on April 11, 2003. This restriction requirement is the same restriction requirement as the present issued by Examiner Muirhei dated December 23, 2003. As a response to the April 11, 2003 communication, Applicants elected without traverse the claims of Group I (claims 26-55) on May 8, 2003. Applicants herein enclose a copy of Examiner Goldberg's restriction requirement, Applicants response, and stamped postcard received from the U.S.P.T.O.

However, in order to facilitate initial examination, Applicants hereby elect without traverse to prosecute the claims of Group I in this application. Applicants election of Group I subject matter at present, however, does not prejudice Applicants' ability to file divisional or continuation applications to unelected subject matter.

The Examiner has further requested that Applicants elect a specific organic non-peptide compound within the scope of claim 26. However, Applicants respectfully note that Claim 26 is a method claim which does not specify a specific compound to be tested. The method claim should not be limited to identifying specific compounds. The purpose of this method claim is to "identify" organic non-peptide compounds useful in the treatment of cancer. If Applicants are forced to elect a specific organic non-peptide compound, which may be identified by this method, it is asking the Applicants to provide a species of the possible resulting compounds. This request places an impossible burden upon the Applicants and Applicants posit that the Examiner can not impose such a request upon the Applicants.

In order to facilitate further examination, the Examiner has also requested that Applicants identify a "specific method of measurement" within the scope of the presented independent claim. To facilitate further examination, Applicants elect spectroscopy as a species of measurement. However, Applicants note that Claim 26 is not so limited, and the various assay methods provided in the specification (see page 37, lines 10-31) are merely representative examples of the wide spectrum of methods that might be used, all of which

would be immediately apparent to one skilled in the art upon review of the present specification.

Applicants clearly understand that the Examiner's request is only one for election of species (37 CFR §1.146) and not a requirement of restriction (37 CFR §1.142). Therefore upon the expected indication of allowability of the species invention, Applicants will be requesting rejoinder of all other "species". Additionally, since the invention is clearly valuable and pioneering, as it has been disclosed and claimed, Applicants seeks allowance of Claim 26 in generic form without limitation or mention of any specific assay technique.

Applicants do not believe any additional fees are due in connection with the filing of this response to the December 23, 2003 Restriction Requirement. However, if any fee is due, the Examiner is authorized to charge the fee to Applicants' Deposit Account No. 16-1445.

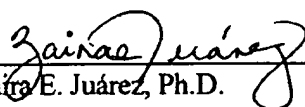
CONCLUSION

Applicants respectfully request prompt consideration of the pending claims and early allowance of the application.

If the Examiner wishes to comment or discuss any aspect of this application or response, Applicants' undersigned attorney invites the Examiner to call her at the telephone number provided below.

Respectfully submitted,

Date: January 23, 2004


Zaira E. Juárez, Ph.D.
Attorney for Applicants
Reg. No. 54,205

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Patent Dept., 5th Floor
150 East 42nd Street
New York, NY 10017
(212) 733-1092

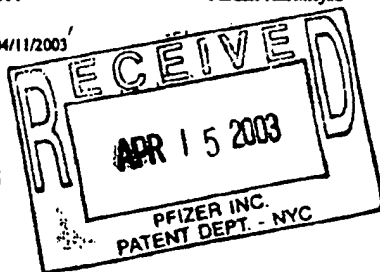


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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,976	05/23/2001	Farzan Rastinejad	PC10228B	1819

7590
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New York, NY 10017-5755



EXAMINER

GOLDBERG, JEROME D

ART UNIT PAPER NUMBER

1614

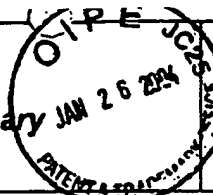
DATE MAILED: 04/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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COPY

Office Action Summary



Application No.

09/863,976

Examiner

Jerome D Goldberg

Applicant(s)

RASTINEJAD ET AL.

Art Unit

1614

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 26-56 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1614

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Restriction to one of the following invention is required under 35 U.S.C. 121.

Group I: claim(s) 26-55, drawn to a method for identifying organic non-peptide compounds useful in the treatment of cancer.

Group II: claim 56, drawn to a method of evaluating whether an organic compound can promote a wide-type activity in a mutant form of a mammalian protein of the p. 53 family.

The several inventions above are independent and distinct, each from the other, as they have acquired a separate status in the art cancer as a separate subject matter for inventive effect and require independent searches. It is noted that the a reference to one Group I method would not be a reference to Group II method under 35 U.S.C. 103. Therefore, restriction for examination purposes is proper.

Applicant is required to make a provisional election even though this requirement is traversed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome D. Goldberg whose telephone number is (703) 308-4606. The examiner can normally be reached on Monday through Thursday from 9 AM to 3 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone

Art Unit: 1614

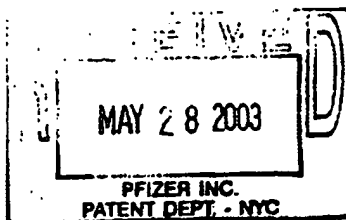
numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Goldberg/LR
March 26, 2003



JEROME D. GOLDBERG
PRIMARY EXAMINER



Date Mailed: May 8, 2003 Express Mail No. _____
Serial No. 09/863,976 Docfat No. PC10228B By ZEJ
Application of Farzan Rastinejad, et al. Filing Date May 23, 2001
Entitled METHODS AND COMPOSITIONS FOR RESTORING CONFORMATIONAL STABILITY OF A PROTEIN OF THE
PS3 FAMILY

The following, has been received in the United States Patent and Trademark Office on the date stamped hereon:

- ☐ Application Transmittal Type:
☐ Specification pages
☐ Claims pages
☐ Abstract pages
☐ Drawing(s) sheets
☐ Declaration with Power of Attorney
☐ Priority Document
☐ Disclosure Statement
☐ Form PTO-FB-A820 (Citation List) References
☐ Sequence Submission (☐ Computer Readable Copy,
☐ Paper copy ☐ Identity Statement)
☐ Copy of Notice to File Missing Parts, Cover Letter
☐ Amendment
☒ Reply to Restriction Requirement



- ☐ Notice of Appeal
☐ Brief (3 copies)
☐ Issue Fee Transmittal
☐ Fee Address Indication Form
☐ Certificate of Correction
☐ Petition for Extension of Time
☐ Fee Transmittal (2 copies)
☐ Associate Power of Attorney
☐ Petition for Expedited Issuance for Foreign
Filing License
☐ Assignment & Recordation Cover Sheet
☒ 1st Class Mail Certificate

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